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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,195	02/19/2004	Carolyn Clancy	FID-009	4100
42532 7590 12/03/2008 PROSKAUER ROSE LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110				
EXAMINER SWARTZ, JAMIE H				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
12/03/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/782,195

**Applicant(s)**

CLANCY ET AL.

**Examiner**

JAMIE H. SWARTZ

**Art Unit**

3694

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 10 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13, 18, 23-25 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13, 18, 23-25 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status***

1. This action is in response to the amendment filed on September 10, 2008. Claims 1-13, 18, 23-25, and 29-32 are pending. Claims 14-17, 19-22, and 26-28 are cancelled. Claims 31 and 32 are new. Claims 1-13, 18, 23-25, and 29-30 are amended.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-13, 18, 23-25, and 29-30 have been considered but are moot in view of the new ground(s) of rejection.
3. Also, Examiner notes that, as per MPEP § 2144.03(C), the statements of Official Notice made in the art rejection have been established as admitted prior art since Applicant has not traversed the Examiner's assertions of Official Notice. More specifically, the following statements of Official Notice are now formally established on record as admitted prior art: However, Official Notice now admitted prior art is taken that an online questionnaire was an old and well known mode of collecting information from customer, clients, even students.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-13, 18, 23-25, and 29-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
6. Claim 1 recites the limitation "the other sponsor provided benefit plans" in lines 19, 21, and 23. There is insufficient antecedent basis for this limitation in the claim.
7. Regarding claims 1 and 30, the phrase "the other sponsor provided benefit plans" renders the claim indefinite because it is unclear what the applicant means by the other sponsor provided benefit plan. Is there a second plan benefit provider being claimed by the applicant?
8. Claim 30 recites the limitation "the other sponsor provided benefit plans" in lines 18, 21, and 23. There is insufficient antecedent basis for this limitation in the claim.
9. Claims 2-13, 18, 23-25, 29, and 31-32 are rejected as being dependent on claims 1 and 30.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1 and 30 are rejected under 35 U.S.C. 101 because the method claims are not attached to another statutory class. Based on a Supreme Court precedent (Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972)) and recent Federal Circuit decisions, it was decided that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and is rejected as being direct to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-3, 6-9, 11, 13, 18, 24-25, 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Toan et al. (US 7376574 B2).

14. Regarding claim 1, Toan teaches a computerized method of assessing the features an employee benefit plan (col. 3, line 24 – col. 14, line 53). Toan teaches receiving a first attribute and a second attribute of a first sponsor provided benefit calculating a first metric based on a value of the first attribute of the first sponsor

provided benefit plan (col. 3, line 24 – col. 14, line 53). Toan teaches calculating a second metric based on a value of the second attribute of the first sponsor provided plan (col. 3, line 24 – col. 14, line 53). Toan teaches determining a subset of other benefit plans (col. 3, line 24 – col. 14, line 53). Toan teaches receiving the first attribute and the second attribute of the subset of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53). Toan teaches calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53). Toan teaches calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53). Toan teaches producing a report including the first attribute, the second attribute, the value of the first attribute of the first sponsor provided benefit plan, the value of the second attribute of the first sponsor provided benefit plan, the subset of other employee benefit plans, the first aggregate metric, the second aggregate metric or any combination thereof (col. 3, line 24 – col. 14, line 53).

15. Regarding claim 2, Toan teaches wherein the first sponsor provided benefit plan comprises a defined contribution plan, a pension plan, and employee stock purchase plan, a deferred compensation plan, a healthcare plan or any combination thereof (col. 3, line 24 – col. 14, line 53).

16. Regarding claim 3, Toan teaches wherein at least one of the other sponsor provided benefit plans is of the same type of sponsor provided benefit plans as the first sponsor provided benefit plan (col. 3, line 24 – col. 14, line 53).

17. Regarding claim 6, Toan teaches a system associated with a record keeper of the first sponsor provided benefit plan the first attributes and the second attribute of the first sponsor provided benefit plan to a system associated with a sponsor of the first sponsor provided benefit plan (col. 3, line 24 – col. 14, line 53).

18. Regarding claim 7, Toan teaches a system associated with a record keeper of the first sponsor provided plan, the first attributes and the second attribute of the other sponsor provided benefit plans to a system associated with the sponsor of the first sponsor provided benefit plan (col. 3, line 24 – col. 14, line 53).

19. Regarding claim 8, Toan teaches a system associated with the sponsor of the first sponsor provided benefit plan, the value of the first attributes and the value of the second attribute of the first sponsor provided benefit plan to a system associated with a record keeper of the first sponsor provided benefit plan (col. 3, line 24 – col. 14, line 53).

20. Regarding claim 9, Toan teaches wherein a single system associated with a single record keeper entity performs record keeping functions for at least two of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53).

21. Regarding claim 11, Toan teaches further comprising using the characteristics of the first sponsor provided benefit plan to determine a subset of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53).

22. Regarding claim 13, Toan teaches wherein the first benefit plan is in the subset of benefit plans (col. 3, line 24 – col. 14, line 53).

23. Regarding claim 18, Toan teaches defining one or more first action items associated with the first attribute and one or more second action items associated with the second attribute (col. 3, line 24 – col. 14, line 53). Toan teaches comparing the first metric and the first aggregate metric (col. 3, line 24 – col. 14, line 53). Toan teaches comparing the second metric and the second aggregate metric (col. 3, line 24 – col. 14, line 53). Toan teaches providing a plan to improve the first employee benefit plan, the action plan comprising one or more of the actions associated with the identified attributes: the first actions items based on the comparison of the first metric and the first aggregate metric; and the second action items based on the comparison of the second metric and the second aggregate metric (col. 3, line 24 – col. 14, line 53).

24. Regarding claim 24, Toan teaches requesting the value of the first attribute of the first sponsor provided benefit plan and the value of the second attribute of the first



sponsor provided benefit plan from a record keeper of the first sponsor provided benefit plan (col. 3, line 24 – col. 14, line 53).

25. Regarding claim 25, Toan teaches requesting the value of the first attribute of the first sponsor provided benefit plan and the value of the second attribute of the first sponsor provided benefit plan from a sponsor of the first sponsor provided benefit plan (col. 3, line 24 – col. 14, line 53).

26. Regarding claim 30, Toan teaches means for receiving a first attribute and a second attribute of a first sponsor provided benefit (col. 3, line 24 – col. 14, line 53). Toan teaches means for calculating a first metric based on a value of the first attribute of the first sponsor provided benefit plan (col. 3, line 24 – col. 14, line 53). Toan teaches means for calculating a second metric based on a value of the second attribute of the first sponsor provided plan (col. 3, line 24 – col. 14, line 53). Toan teaches means for segmenting other sponsor provided benefit plans into a subset (col. 3, line 24 – col. 14, line 53). Toan teaches receiving the first attribute and the second attribute of the subset of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53). Toan teaches means for calculating a first aggregate metric based on values of the first attribute of the subset of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53). Toan teaches means for calculating a second aggregate metric based on values of the second attribute of the subset of the other sponsor provided benefit plans (col. 3, line 24 – col. 14, line 53). Toan teaches means for producing a report including

the first attribute, the second attribute, the value of the first attribute of the first sponsor provided benefit plan, the value of the second attribute of the first sponsor provided benefit plan, the subset of other employee benefit plans, the first aggregate metric, the second aggregate metric or any combination thereof (col. 3, line 24 – col. 14, line 53).

27. Regarding claim 31, Toan teaches performing the comparison of the first metric and the first aggregate metric and the comparison of the second attribute and the second aggregate metric for one or more of the following plan metrics: plan participation, plan diversification, participant contribution levels, participant account balances, and participant interaction (col. 3, line 24 – col. 14, line 53).

28. Regarding claim 32, Toan teaches performing the comparison of the first metric and the first aggregate metric and the comparison of the second attribute and the second aggregate metric for one or more of the following metrics: the age of plan participants, the diversification of plan options, and customer service channels used by plan participants (col. 3, line 24 – col. 14, line 53).

### ***Claim Rejections - 35 USC § 103***

29. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

30. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toan et al. (US 7376574 B2) in view of Mahoney et al. (US 20030182147 A1).

31. Regarding claim 4, Toan teaches benefit plans but does not specifically teach 401 (k) plans. However, Mahoney teaches wherein the defined contribution plan is one of a 401 (k) plan and a 403(b) plan (§ 25, 28, 55, 65). Toan teaches optimizing the design of benefit plans offered to a given participant population by preferably prioritizing plan design options that can be incorporated in such plans according to the relative perceived benefits derived from each option. Mahoney teaches computer systems programmed to process transactions in benefit plans. It would have been obvious to one ordinary skill in the art at the time of the invention to modify Toan to teach 401 (k) plans as Toan teaches benefit plans. A 401 (k) plan is a type of a benefit plan.

32. Claim 5, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toan et al. (US 7376574 B2) in view of Manning (US 20040088236 A1).

33. Regarding claim 5, Toan teaches providing attributes of employee benefit plans, determining subsets of plans. Toan does not specifically teach a 457 plan. However, Manning teaches wherein the deferred compensation plan is a 457 plan (§ 18, 25). Toan teaches various employee benefit plan options. Manning teaches an analysis and modeling of retirement investments during a pre-retirement accumulation phase and a post-retirement distribution phase with various employee benefits plan options. The

claim is rejected under 35 USC 103 as obvious over the primary reference in view of the secondary reference. The primary reference teaches different employee benefit plan options including options such as the 401 (k) plan. The sole difference between the primary reference and the claimed subject matter is that the primary reference does not disclose the 457 plan. The secondary references disclose the 457 plan which is a non-qualified, deferred compensation plan established by state and local governments and tax-exempt governments and tax-exempt employers. Eligible employees are allowed to make salary deferral contributions to the 457 plan. Earnings grow on a tax-deferred basis and contributions are not taxed until the assets are distributed from the plan. The secondary reference shows the use of the 457 plan. Since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself- that is the substitution of the 457 plan. Thus, the simple substitution of one known element for another produces a predictable result renders the claim obvious.

34. Regarding claim 29, Toan teaches benefits but does not specifically teach a printed report and a webpage. However, Mahoney teaches wherein the action plan is displayed on one or more of a printed report and a web page (§§ 80, 84, 88). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Toan to include printing and displaying a report on a webpage. Both uses of displaying were old and well known at the time of the invention for reporting and displaying the plan.

35. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toan et al. (US 7376574 B2) in view of Official Notice.

36. Regarding claim 10, Toan teaches benefit plans but does not specifically teach two different entities associated with two other benefit plans. However, Official Notice is taken that it is well known in the art at the time of the invention for the existence of multiple record keepers.

37. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toan et al. (US 7376574 B2) in view of Newman (US 20020103680 A1).

38. Regarding claim 12, Toan teaches providing attributes of employee benefit plans, determining subsets of plans. Toan does not specifically teach determining the subsets. However Newman teaches wherein the characteristics used to determine the subset includes one or more of: the number of employees, industry, non-profit status, and geographic region (¶ 103, 208). Toan teaches various benefit plan options. Newman teaches managing the provision and administration of employee benefits. Both Toan and Newman teach plan benefits. Toan teaches all the claimed process steps with the exception of the specific characteristics to determine subsets. Newman teaches the characteristics claimed for setting up a subset. Since the purpose of locating characteristics for the subset is to better assess an employee benefit plan it would have

been obvious to include more specific details about the employee benefit plan. The number of employees, the industry, the non-profit status, and location all are major factors in assessing the attributes of an employee benefit plan. Each of those factors affects features that are available and even the rates of the features that are available. The practice of assessing a group of employee benefit plans based on key characteristics is well known in the business community. When figuring out which features should be involved in a subset it is always important to note key features. Therefore, it would have been obvious to try, by one of ordinary skill in the art at the time of the invention, to pick the number of employees, the industry, the non-profit status, or the location as key characteristics to creating a subset of employee benefit plans and one of ordinary skill in the art could have pursued the known potential solutions with a reasonable expectation of success.

39. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toan (US 7376574 B2) in further view of Official Notice now admitted prior art.

40. Regarding claim 23, Toan teaches benefit plans. Toan does not specifically state the use of a questionnaire. Official Notice now admitted prior art is taken that an online questionnaire was an old and well known mode of collecting information from customer, clients, even students.

### ***Conclusion***

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMIE H. SWARTZ whose telephone number is (571)272-7363. The examiner can normally be reached on 8:00am-4:30pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. H. S./  
Examiner, Art Unit 3694

/James P Trammell/  
Supervisory Patent Examiner, Art Unit 3694